

other and materially different products or (2) that the product *as claimed* can be made by another and materially different process.

Product claim 1 recites a scaffold material comprising sintered glass or ceramic fibers and wherein the scaffold material is porous. Method of making claim 38 recites a method of making a scaffold by contacting glass or ceramic fibers together and sintering the glass or ceramic fibers in a manner to produce a porous scaffold.

A comparison of the product claim 1 and the method of making claim 38 reveals that each claimed invention recites a porous scaffold material of sintered glass or ceramic fibers. Referring to the method of making claim 38, applicants respectfully submit that the method of making invention *as claimed* cannot be used to make other and materially different products since the claim itself recites the production of a porous scaffold of sintered glass or ceramic fibers, i.e. following the steps of the method claim, one would end up with a porous scaffold of sintered glass or ceramic fibers. Referring to the product claim 1, applicants respectfully submit that the product *as claimed* cannot be made by another and materially different process since the claim itself recites a porous scaffold of sintered glass or ceramic fibers, i.e. glass or ceramic fibers are required to be sintered together to form a porous scaffold.

In addition, claims directed to a product and a method of using the product can be properly restricted only if the following can be shown: (1) the process of using *as claimed* can be practiced with another materially different product or (2) the product *as claimed* can be used in a materially different process. MPEP 806.05(h). Referring to method of use claim 49, applicants note that the method of use *as claimed* recites the use of a porous scaffold formed by sintering together glass fibers to allow bone growth into the porous scaffold. Applicants respectfully submit that the method of use *as claimed* cannot be used with a materially different

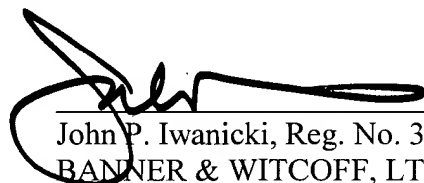
product since the method of use claim itself recites a porous scaffold formed by sintering together glass fibers. In addition, the product as claimed cannot be used in a materially different process since the claim itself recites a scaffold which is commonly understood to be a product that is implanted and on which tissue grows.

The Examiner's basis for requiring restriction, namely that "ceramic fibers can be used to make a scaffold material" is not persuasive in view of the tests set forth above. Applicants alternatively claim ceramic fibers in the scaffold of claim 1 Group I and in the method of making the scaffold Group II claim 38. Applicants believe that the subject matter of claims 1 – 37 and 38 – 49 is so interrelated to the extent that a search and examination of the subject matter of those claims in the same application would not be over-burdensome. Accordingly, applicants request the withdrawal of the restriction requirement.

Notwithstanding, applicants elect the invention of Group I claims 1 – 37 for prosecution on the merits.

Respectfully submitted,

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